

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARIS MARDIROSSIAN

Appeal No. 2000-0264
Application No. 08/752,624

ON BRIEF

Before JERRY SMITH, GROSS, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 6-9, and 12-17, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a global paging system using packet-switched digital data network and remote country designation. An understanding of the invention can be derived

from a reading of exemplary claim 12, which is reproduced as follows:

12. A global country-selective paging system comprising:

a plurality of web sites or servers, each of said sites or servers being located in a different country around the globe;

a land based packet-switched digital data network interconnecting said plurality of servers around the globe;

a pager to be paged belonging to a receiving user;

means for allowing an originating user to communicate with a first web site or server in a first country in order to page the receiving user who's pager is located in a second country different than the first country;

means for transmitting a paging message from said originating user to said first web site or server, then to a second web site or server located in the second country, and then to said pager of the receiving user; and

designating means for designating the second country.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lucas et al (Lucas)	4,644,347	Feb. 17, 1987
Gaskill et al (Gaskill)	4,713,808	Dec. 15, 1987
Oliwa	5,237,321	Aug. 17, 1993
Kane	5,487,100	Jan. 23, 1996

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kane in view of Lucas and further in view of Gaskill.

Claims 6-9 and 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kane in view of Lucas and Gaskill, and further in view of Oliwa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 9, mailed April 27, 1999) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 8, filed February 1, 1999) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the brief along with the

examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm in part.

We begin with the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Kane considered with Lucas and Gaskill.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ

657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Appellant asserts (brief, page 5) that "Kane does not disclose or suggest a global paging system with different servers in different countries being utilized and communicating via a packet-switched network as claimed by applicant. Kane cannot designate a secoud [sic] country as claimed by applicant."

Appellant further asserts (brief, page 7) that "[t]he references are not combinable in the way provided in the rejection, and even if they were the invention of claim 1 still cannot be met."

The examiner (answer, page 4) acknowledges that "Kane does not disclose the E-mail message being sent to a second country

and Kane does not disclose the originator addressing a message to the second country server." To overcome these deficiencies in Kane, the examiner turns to Lucas (answer, pages 5 and 6) for a teaching of originating a message in one city and terminating the message in a second city. The examiner asserts that it would have been obvious to expand the local system of Kane to a regional system. The examiner additionally (answer, pages 6 and 7) relies upon Gaskill for a teaching of sending messages globally, and in particular for a teaching of addressing messages to a server in a second country.

We find that Kane is directed to an electronic mail delivery system for delivering messages. A paging terminal is coupled to the electronic mail network (col. 1, line 65 through col. 2 line 5). As shown in figure 1, computer 104 and telephone 106 access the input of central terminal 102 via a Public Switched Telephone Network (PSTN) to initiate page requests (col. 3, lines 4-10). Paging transmitter systems 124, 126 route messages from central terminal 102 for reception by selective call receivers 130, which preferably incorporate paging receivers 134 (col. 3, line 66 through col. 4, line 11).

We find that Lucas is directed to a pager which automatically switches from a local frequency to a nationwide

frequency and vice-versa (col. 1, lines 52-55). A user receives local pages at a home city frequency, and pages at a nationwide frequency when outside of the user's local area (col. 2, lines 43-48). Transmission at the nationwide frequency is via satellite or land-line link as shown in figure 1. When a user leaves city L1, the user reports his absence to the local Radio Common Carrier (RCC), which adjusts the system so that pages for the user will be diverted to the nationwide system. The nationwide system then transmits the messages to the user in all cities or to a specific city (col. 2, lines 60-66). If a user travels from city L1 to city L2, the pager finds a special code for L2 (absence of L1) in the transmissions and determines that it is not in city L1. The pager/receiver then switches channels to the nationwide frequency (col. 6, lines 3-9).

We find that Gaskill (col. 4, lines 21-28) is directed to a paging system that operates within any desired area, including local, regional, national, continental, and worldwide communication capability, without displacing local area access to the paging system. Paging requests are transmitted from local area transmitting means in the form of packets. Page requests are transmitted by telephones 24 and personal computers (col. 6, lines 40-43). A sending user transmits a request by dialing the

local paging telephone number on telephone 24, and provides the telephone number of the receiving user. After the information is confirmed, the sending user can call the number entered (option 4). The number can be up to fifteen digits col. 7, line 54 through col. 8, line 19).

From our review of Kane, we find no disclosure of whether or not Kane is directed to a global paging system. However, from the disclosures of Kane and Gaskill of initiating pages using a telephone or computer, and Lucas' teaching of using a land-line link to diverse areas, we find that an artisan would have been motivated to combine the teachings of Kane, Lucas, and Gaskill to make the E-mail paging system of Kane operate in a global fashion. We find that an artisan would have recognized the advantages of having an e-mail paging system that operated in a global fashion, in order to allow use of the system by a larger number of individuals. We agree with appellant (brief, page 6) that Lucas is not directed to a global paging system, but rather is directed to a nationwide paging system. However, for the reasons stated above, we find that Gaskill teaches a global data communications network 124, as shown in figure 2A; see also col. 13, lines 57-60).

However, we are persuaded, for the reasons which follow, by appellant's assertion (brief, page 7) that the prior art does not disclose or suggest the step of an originating user designating one of a plurality of countries during an E-mail to a first of two servers. Claim 1 requires the step of e-mailing a paging signal to a first server or web site in a first country, the paging signal including, inter alia, a pager I.D., and the step of designating a second country from a plurality of potential countries in which the receiving user is to be paged. The examiner's position (answer, page 6) is that "[i]nclusion of a country code in the number to specify the country, region or nation where the message is to be transmitted is discussed in col. 8, line 56 - col. 9, line 5." However, the portion of Gaskill relied upon by the examiner relates to the instruction associated with key 7, and is used by the receiving user, not the sending user, as required by claim 1. In any event, if we considered the telephone number of a receiving user in a foreign country to be the pager I.D. number inputted by the sending user, as advanced by the examiner, claim 1 would not be met because the pager I.D. number, including the country code, would have already been entered by the originating user, and the additional claimed step of designating a second country code would not be

met. Thus, even if the pager I.D. number represented a different country from the number of the local server, i.e., paging someone in a foreign country, the paging I.D. signal would include the country code of the person being called in the second country, and there would be no reason, nor any teaching or suggestion in the prior art, to enter the country code of the paging I.D. a second time. Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of claim 1. The rejection of claim 1 under 35 U.S.C. § 103(a) is therefore reversed.

We turn next to the rejection of claims 6-9 and 12-17 under 35 U.S.C. § 103(a) as unpatentable over Kane considered with Lucas, Gaskill and Oliwa. We begin with independent claim 6. We make reference to our findings, supra, with respect to the teachings of Kane, Lucas, and Gaskill. We observe that claim 6 is of different scope than claim 1. Claim 6 recites that the originating user telephones the first web site or server in a first country to page the receiving user who is located in a different country, with the originating user not necessarily knowing what country the receiving user is located in. We find that in Gaskill (col. 8., lines 56-68) the receiving user can call the system and by pressing key 7, the user can enter the

telephone number from which he is calling, including the country code. This allows the system to know where to send the user's receiving messages, and all of his messages from the last 24 hours will be retransmitted. From this disclosure of Gaskill, an originating user will be able to page the receiving user without necessarily knowing what country the receiving user is in.

However, Gaskill does not disclose that the paging system determines if the second country currently designated by the receiving user is the designated country in which the paging system is to first attempt to page the receiving user, as Gaskill retransmits messages to a different number than the receiving user's pager number. However, in view of the teachings of Lucas (col. 6, lines 3-9) of the system automatically determining if the pager was outside of the user's home area and automatically forwarding the pages to the user throughout the entire area covered by the system, and in view of Oliwa's teaching (col. 4, lines 6 and 7) of the system automatically determining if the pager was outside of the user's home area and automatically forwarding the pages to the user at a different network, we find that an artisan would have been motivated to automatically detect the location of the user, instead of requiring the user to call the system with a telephone number at which he could be reached.

However, claim 6 additionally requires that "when the paging system determines that the second country has not been designated by the user, the paging system initiates paging operations in a predetermined list of different countries in a predetermined order in an attempt to page the receiving user." The examiner's position (answer, page 8) is that it would have been obvious to expand Oliwa's list of two locations to any number of areas. However, we find that Oliwa discloses (col. 4, lines 8-25) that in a system with two networks such as an on-site network and a surrounding wide area paging network, that terminal 28 would inherently know to which alternate paging network to transfer the page. However, Oliwa continues that in the embodiment of a nationwide or worldwide paging scheme, the wearer of the pager would have to inform the Paging Network System One "of which paging network system he would be able to receive." Thus, we find no suggestion, other than from appellant's disclosure, of "when the paging system determines that the second country has not been designated by the user, the system initiates paging operations in a predetermined list of different countries in a predetermined order in an attempt to page the receiver user." Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of claim 6. Accordingly, the

rejection of claim 6, and claims 7-9 dependent therefrom, is reversed.

We turn next to claims 12-17. For the reasons which follow, we affirm the rejection of claims 12-14 and reverse the rejection of claims 15-17. We make reference to our findings, supra, with respect to the teachings of the prior art. Appellant asserts (brief, page 10) that the prior art "does not disclose the means in the instant specification, or equivalent thereto" for:

(a) allowing an originating user to communicate with a first web site or server in a first country in order to page the receiving user who's pager is located in a second country; (b) transmitting a paging message from said originating user to said first web site or server, then to a second web site or server located in the same country; (c) designating the second country; (d) allowing the originating user to designate the second country when the originating user communicates with the first web site or server, and (e) allowing the receiving user to designate the second country for future pages to said pager so that when the receiving user is paged in the future, the paging system will first attempt to page said pager of the receiving user in the designated second country.

However, appellant has failed to provide any reasons why appellant considers the structure of the prior art to not be the same as or equivalent to the structure disclosed in appellant's specification. With respect to (a) and (d), the identical function of the means-plus-function clause is met by Gaskill's allowing of an originating user to call a local paging number in a first country in order to page a receiving user who is located in a second country. We distinguish (d) from claim 1 because claim 1 requires the originating user to enter a paging I.D. With respect to (b) we find that the identical function of the means-plus-function language is met by col. 15, lines 39-42 of Gaskill which disclose that if the requested number is outside the local subscriber data base, a request for roamer information is made at step 262 (figure 3A) over the international network to the proper clearinghouse. With respect to (c), the identical function of the means-plus-function clause regarding the designating means is met by the country code inputted as part of the up to fifteen digit paging number inputted by the originating caller in Gaskill (col. 8, lines 16-19). With regard to (e) we make reference to our findings, supra, with respect to claim 6. With regard to whether the structure disclosed by the prior art for carrying out the claimed means is the same as or is

equivalent to that of appellant, we find that appellant's specification broadly describes the system as being composed of towers, transmitters, receivers, web site/servers, telephone and PCS, cell phones, pagers, etc; see i.e., figure 1. We find that the prior art discloses similar components; see i.e., figure 2A of Gaskill, figure 1 of Kane, and figure 2 of Oliwa, and therefore conclude that the means-plus-function language of claim 12 is met by the prior art. Accordingly, we find that the examiner has established a prima facie case of obviousness of claims 12-14 that has not been successfully rebutted by appellant. We therefore affirm the rejection of claims 12-14 under 35 U.S.C.

§ 103(a).

Turning to claim 15, we reverse the rejection of claim 15 based upon our findings, supra, with respect to claim 6. Accordingly, the rejection of claim 15, and claims 16 and 17 which depend therefrom, under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 6-9 and 15-17 under 35 U.S.C. § 103(a) is reversed. The decision of the examiner to reject claims 12-14 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a).

AFFIRMED-IN-PART

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